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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,627

02/18/2004

John C. Reed

66821-276

5834

7590 08/06/2008
Cathryn Campbell
McDERMOTT, WILL & EMERY
4370 La Jolla Village Drive, Suite 700
San Diego, CA 92122

EXAMINER

RAWLINGS, STEPHEN L

ART UNIT

PAPER NUMBER

1643

MAIL DATE

DELIVERY MODE

08/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/782,627	Applicant(s) REED ET AL.	
	Examiner Stephen L. Rawlings	Art Unit 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 4, 2008, has been entered.

1. The amendment filed May 12, 2008, has been entered in part¹. Claims 6-33 have been canceled. Claim 5 has been amended.

2. Claims 2-5 are pending in the application and are currently under prosecution.

Terminal Disclaimer

3. The terminal disclaimer filed on May 12, 2008, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,696,558 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Oath/Declaration

4. The objection to the declaration filed May 12, 2008, which was noted in the Office communication mailed May 22, 2008, has been withdrawn.

Regarding the date of execution of the oath/declaration, M.P.E.P. § 602.05 states:

The Office no longer checks the date of execution of the oath or declaration and the Office will no longer require a newly

¹ The amendment to the specification filed May 12, 2008, is not compliant, as indicated in the Office communication mailed May 22, 2008, and has not been entered.

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executed oath or declaration based on an oath or declaration being stale (that is when the date of execution is more than 3 months prior to the filing date of the application) or where the date of execution has been omitted. However, applicants are reminded that they have a continuing duty of disclosure under 37 CFR 1.56.

Grounds of Objection and Rejection Withdrawn

5. Unless specifically reiterated below, entry of the amendment filed May 12, 2008, has obviated or rendered moot the grounds of objection and/or rejection set forth in the previous Office action mailed January 4, 2008.

Ground of Objection Maintained

Specification

6. The objection to the specification because the use of improperly demarcated trademarks is maintained. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks. See MPEP § 608.01(v).

As previously noted in the Office action mailed January 4, 2008, an additional example of an improperly demarcated trademark appearing in the specification is BiaCore™; see, e.g., page 33, line 2.

Again, appropriate correction is required. Each letter of a trademark should be capitalized or otherwise the trademark should be demarcated with the appropriate symbol indicating its proprietary nature (e.g., ™, ®), and accompanied by generic terminology. Applicants may identify trademarks using the “Trademark” search engine under “USPTO Search Collections” on the Internet at <http://www.uspto.gov/web/menu/search.html>.

Note: Applicant is reminded that the amendment to the specification filed May 12, 2008, is not compliant with the requirements set forth under 37 C.F.R. § 1.121 and has not been entered.

Grounds of Rejection Maintained

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. The rejection of claims 2-5 under 35 U.S.C. 102(a), as being anticipated by Takayama et al. (*GENEMBL Accession Number AF022224; 03 September 1998*), is maintained.

The claims are drawn to a substantially purified nucleic acid molecule having the polynucleotide sequence set forth in SEQ ID NO: 1, which encodes the protein of SEQ ID NO: 2.

Takayama et al. teaches a substantially purified nucleic acid molecule consisting of an identical polynucleotide sequence as that set forth in SEQ ID NO: 1; see entire document.

As explained in the Office communication mailed May 22, 2008:

With regard to the merit of the declaration under 37 C.F.R. § 1.132 by John C. Reed and Shinichi Takayama, it is noted that Applicant has not provided a showing of good and sufficient reasons as to why the declaration is necessary, but was not presented earlier before prosecution was closed. Nonetheless, were the merit of this declaration considered, it is aptly noted that it states only that authors K. Kochel, S. Irie, J. Inazawa, T. Abe, T. Sato, T. Druck, and K. Huebner worked under the direction and supervision of John C. Reed and Shinichi Takayama, and fails to state that Applicant is the sole inventor of the claimed invention. See M.P.E.P. § 715.01(c): "An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)." Thus, the declaration under 37 C.F.R. § 1.132 by John C. Reed and Shinichi Takayama filed May 12, 2008, has been entered but cannot be considered proper or sufficient to overcome the rejection of claims 2-5 under 35 U.S.C. § 102(a) for the reason set forth in section 15 at page 8 of the prior Office action mailed January 4, 2008.

Conclusion

9. No claim is allowed.

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen L. Rawlings/

Stephen L. Rawlings, Ph.D.
Primary Examiner, Art Unit 1643

slr
August 1, 2008